

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Ayumu KURIMOTO et al.

Patent No. 8,012,964

Confirmation No. 3128

Issued: September 6, 2011

Art Unit: 1624

For: 9-SUBSTITUTED 8-OXOADENINE
COMPOUND

Examiner: M. L. Berch

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
UNDER 37 CFR § 1.705(d)

November 4, 2011

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

Pursuant to 37 CFR § 1.705(d), the Patentee hereby requests reconsideration of the Patent Term Adjustment (PTA) indicated on the face of US Patent 8,012,964 (hereinafter “the ‘964 patent”). Specifically, while the face of the issued patent indicates a PTA of 512 days, Patentees’ calculation suggests a PTA of only 404 days.

STATEMENT OF FACTS

1. The first Notice of Allowance issued in the prosecution of this patent on November 19, 2009. Subsequent to that paper, the prosecution of the application continued by a series cycles of Requests for Continued Examination and Information Disclosure Statements followed by Notices of Allowance, sometimes including the filing of an Amendment with a Request for Continued Examination. These cycles concluded with issuance of a Notice of Allowance on April 18, 2011.

2. The final Notice of Allowance of April 18, 2011 indicated a PTA of 429 days. Patentee's analysis of the PTA at that time concluded that the application was entitled to only 267 days and on July 8, 2011, Patentees filed a letter requesting reconsideration of the PTA accorded to the patent to issue.

3. The present patent issued on September 6, 2011 indicating on its face a PTA of 512 days. A copy of the front page of the '964 patent is attached hereto.

4. Patentees have subsequently undertaken re-analysis of the PTA to be accorded to this patent and conclude that the correct PTA is only 404 days.

5. A supplemental response (Preliminary Amendment) was filed on July 6, 2009 after the initial response to the Restriction Requirement was filed on May 1, 2009. Therefore, the USPTO should have deducted 66 days of PTA. On December 1, 2010, a supplemental amendment was filed after a Request for Continued Examination (RCE) was filed on October 12, 2010. Therefore, the USPTO should have deducted 50 days of PTA. On December 21, 2010 an IDS was filed after the RCE was filed on October 12, 2010. Therefore, the USPTO should have deducted an additional 20 days of PTA. On April 5, 2011, an IDS was filed after an RCE was filed on March 10, 2011. Therefore, the USPTO should have deducted an additional 26 days of PTA.

6. Further, the discrepancy includes 54 days of PTA charged to the applicant in connection with the Letter filed in the USPTO on July 8, 2011 to report an error in the USPTO PTA calculation (which 54 days of PTA should not be deducted) and a 7 day PTA charge to the applicant in connection with the 312 Amendment filed on July 8, 2011 (which is an appropriate charge).

STATEMENT OF RELIEF REQUESTED

The USPTO is respectfully requested to correct the record of the '964 patent to reflect a correct PTA of 404 days, and to issue a Certificate of Correction, without charge to the Patentees to correct the face of the '964 patent to recite the correct PTA of 404 days.

As this filing of this petition was necessitated by error on the part of the USPTO, Patentees further request refund of the petition fee of \$200 paid pursuant to 37 CFR §§ 1.705(b)(1) and (d) paid herewith to Deposit Account 02-2448.

COMPLIANCE WITH REQUIREMENTS OF 37 CFR § 1.705(b)(1) and (2)

A Statement of Facts is presented above, detailing the relevant dates and the correct patent term adjustment.

The present patent is not subject to any Terminal Disclaimer.

As required by 37 CFR § 1.705(b)(1) and (d), the payment of the fee set forth in 37 CFR § 1.18 is supplied.

PAYMENT OF FEES

As set forth in the attached Fee Transmittal, the Commissioner is hereby authorized to charge the amount of \$200.00 to Deposit Account No. 02-2448 for the consideration of this Request as required by 37 CFR § 1.18(e).

If necessary, the Director is hereby authorized in this, concurrent, and future replies to charge any fees required during the pendency of the above-identified patent or credit any overpayment to Deposit Account No. 02-2448.

Dated: November 4, 2011

Respectfully submitted,

By Mark J. Nuell
Mark J. Nuell, Ph.D.
Registration No. 36,623
BIRCH, STEWART, KOLASCH & BIRCH, LLP
12770 High Bluff Drive, Suite 260
San Diego, California 92130
(858) 792-8855
Attorney for Applicant

Attachments: Front Page '964 Patent
Fee Transmittal